

REMARKS

Applicant has reviewed the Office Action mailed September 3, 2003. Claims 27 and 37 have been cancelled and claims 2, 7, 10, 11, 13, 18, 21, 22, 23, 26, 31, 36, 41, and 46 have been amended by this Response. Thus, claims 2 through 11, 13 through 26, 28 through 36, and 38 through 48 are pending in the application. Applicant hereby requests further examination and reconsideration of the application in view of the following remarks.

Claim Rejection Under 35 U.S.C. §103

Claims 2-11, 26-33, 35, 41-42 and 45-46 were rejected under 35 U.S.C. §103(a) as being unpatentable over Kambe, et al. (U.S. 5,938,979) in view of Lian et al. (U.S. 6,327,145). Additionally, claims 13-25, 34, 36-40, 43-44, and 47-48 were rejected under 35 U.S.C. §103(a) as being unpatentable over Lian et al. (U.S. 6,327,145) (hereinafter referred to as "Lian") in view of Kambe, et al. (U.S. 5,938,979) (hereinafter referred to as "Kambe"). Applicant respectfully traverses both rejections.

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Ryoka*, 180 U.S.P.Q. 580 (C.C.P.A. 1974). *See also In re Wilson*, 165 U.S.P.Q. 494 (C.C.P.A. 1970). The Kambe reference fails to teach "an Mu metal" as recited in independent claims 2, 7, 10, 11, 13, 18, 21, 22, 23, 26, 31, 36, 41 and 46. The Patent Office correctly stated this in the current Office Action, "Kambe et al does not teach the magnetic shielding alloy includes Mu metals." Advantageously, the Mu metals (created from nickel iron alloys) provide extremely high magnetic permeabilities which persist up to the microwave region. Thus, the Mu metals provide a significant electromagnetic shielding characteristic while maintaining a soft and malleable state advantageous for use in the present invention.

The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. It is impermissible to use the claimed invention as an instruction manual or 'template' to piece together the teachings of the prior art so that the claimed invention is rendered obvious. *In re Oetiker*, 977 F.2d 1443, 24 USPQ 2d 1443 (Fed. Cir. 1992) *quoting In re Fine*, 837 F.2d 1071, 1075, 5 USPQ 2d 1596, 1600 (Fed. Cir. 1988). The Patent Office asserts that it would have been obvious to modify the

Kambe reference to include the Mu metals of the present invention. Applicant respectfully disagrees. Nowhere in the Kambe reference does it teach, suggest, or disclose modification to include the use of Mu metals.

As the Office is well aware, Applicants are required to seasonably challenge statements by the Office that are not supported on the record. M.P.E.P. §2144.03. Further, it is noted that "Official Notice" is to be limited to instances where the facts are "capable of instant and unquestionable demonstration as being well-known". M.P.E.P. §2144.03. This is not the present situation. First, in accordance with M.P.E.P. §904 it is presumed that a full search was conducted and this search is indicative of the prior art. The search identified the Kambe reference, which fails to teach, suggest, or disclose the employing of Mu metals. Further, the search failed to disclose a reference which would teach or suggest modifying the Kambe reference to achieve the present invention wherein an Mu metal is employed for electromagnetic shielding. Consequently, the search revealed that the asserted substitution is not well-known and therefore is not entitled to be relied upon in order to reject the present claimed invention. If the Office is unable to provide such a reference, and is relying on facts based on personal knowledge, Applicants hereby request that such facts be set forth in an affidavit from the Examiner under 37 C.F.R. 1.104(d)(2). Absent substantiation by the Examiner, it is respectfully requested that the rejection under 35 U.S.C. § 103 be withdrawn.

Claims 3-6, 8-9, 14-17, 19-20, 24-25, 28-30, 32-35, 38-40, 42-45, and 47-48 are believed to be allowable based on dependence from an allowable claim.

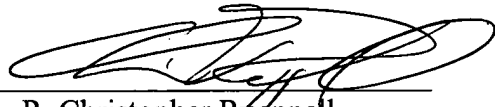
CONCLUSION

In light of the forgoing, reconsideration and allowance of the claims is earnestly solicited.

Respectfully submitted,
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By: _____



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